

REMARKS/ARGUMENTS

Claims 1 - 29 are currently pending. Claims 1, 8, 12, 14, and 15 have been amended. Claims 17 - 29 have been added. No new matter has been added. Support for the amended and added claims may be found throughout the application as originally filed.

Claim 15 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 15 have been amended to depend from claim 14 to address the rejection. Claim 15 should be patentable as claim 15 is dependent from allowed claim 14.

Claims 1 - 5, 7 - 8, and 11 - 13 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bohn (U.S. Published Patent Application No. 2003/0006965) in view of Chinen (U.S. Patent No. 6,099,929).

Claims 6, 9, 10, 14, and 16 are objected to as being dependent upon a rejected base claim, but would be allowable is rewritten in independent form including all of the limitations of the base claims and any intervening claims.

Claim 1 has been amended to overcome the obviousness rejection over Bohn in view of Chinen. Specifically, claim 1 has been amended to recite, "said cantilever mounting providing a spring force for the free extending button to return the free extending button to a neutral position subsequent to being pressed by a user." Support for amended claim 1 may be found in the application as originally filed at page 4, paragraph 20 among other places.

Bohn and Chinen, either alone or in combination, fail to teach or suggest every limitation of claim 1 as amended. Specifically, Bohn discusses a mouse having left and right buttons 14 and 16 configured to light LEDs 22 and/or 26 if either of the buttons is depressed. Applicants are in agreement with the Examiner that Bohn fails to teach or suggest a free extending button integrally formed with a top housing. As Bohn fails to teach or suggest the free extending button of claim 1, Bohn also fails to teach or suggest a free extending button that has a cantilever mounting that provides a spring force to return the free extending button to a neutral position subsequent to being pressed by a user. Chinen fails to make up for the deficiencies of Bohn. Specifically, Chinen discusses a flexible protective cover having an adhesive strip configured to attach the cover to a control device. Chinen's protective cover includes one or two

extending cover sections that are configured to cover the buttons of a control device. Nowhere does Chinen teach or suggest the protective cover is configured to provide a spring force to return the extending portions of the cover to a neutral position subsequent to being pressed by a user. Therefore, Chinen does not make up for the deficiencies of Bohn. Therefore, claim 1 as amended is not obvious over Bohn in view of Chinen.

The rejection of claim 12 is traversed as Bohn and Chinen, either alone or in combination, fail to teach or suggest every limitation of claim 12. For example, Bohn and Chinen fail to teach or suggest "an island mounted on said body between said extending buttons, said island having lips extending over edges of said extending buttons so that a gap between said extending buttons and said island is not visible from above." Specifically, the Examiner rejected claim 12 asserting that the limitation of the island having lips that extend over the edges of the extending buttons is a matter of comfort and/or appearance. Applicants understand the Examiner's rejection as being for obvious subject matter over Bohn and Chinen as the lips of the island are allegedly for *comfort*. Applicants further understand the Examiner's rejection as being for non-patentable subject matter under 35 U.S.C. § 101 as limitations directed to elements that do provide a function but are for ornamentation or *appearance* are not given patentable weight (MPEP § 2144.04 paragraph I, § 2105, and § 2106). If Applicants misunderstand the Examiner's rejection, it is respectfully requested that the Examiner further explain the rejections.

Regarding the Examiner's rejection that the claims are obvious in view of Bohn and Chinen as the lips of the island are for comfort. As an initial matter, Applicants submit that the lips of the island function to limit the upward travel of the extending buttons. This functionality of the lips is described in the application as originally filed at page 4, paragraph 20. Limiting the upward travel of the extending buttons below the lips of the island provides a number of functions including: i) positioning the buttons at a known height to provide uniform operability of the buttons for a user, ii) providing a known amount of initial spring resistance to the buttons as well as other functions that will be readily apparent to those of skill in the art. Accordingly, the lips of the islands are not merely provided for comfort.

As an additional matter, neither Bohn nor Chinen teach or suggest an island having lips that extend over the edges of extending buttons. While Bohn shows a structure (un-

numbered in Bohn's FIG. 1 and 6) partially surrounding a scroll wheel 18, the mechanical features of the structure are not described in Bohn, and certainly Bohn provides no description that the structure includes lips that cover edges of extending buttons. Chinen fails to make up for this deficiency of Bohn. Specifically, in Chinen's FIGs. 1 and 2, no island is shown disposed between buttons 2 and 3, and no island is described anywhere in Chinen that includes lips that extend over the edges of extending buttons. The only structure shown in Chinen's FIGs. 1 and 2 that is disposed between Chinen's buttons 2 and 3 is a scroll wheel 13. As Chinen's fails to even mention an "island mounted on said body between said extending buttons," as recited in claim 12, Chinen certainly fails to show an island "having lips extending over edges of said extending buttons," also recited in claim 12. Because the lips of the island are not provided merely for comfort, and because Bohn and Chinen fail to teach, or even suggest, the foregoing described limitations of claim 12, Bohn and Chinen fail to render claim 12 obvious.

Regarding the Examiner's assertion that claim 12 is not patentable because the lips of the island are for *appearance*, a number of functions for the lips have been described above and are described in the application as originally filed. The described functions clearly demonstrate that the lips of the island are not merely for appearance, but that the lips provide mechanical functions. Therefore, the lips of the island constitute patentable subject matter under 35 U.S.C. § 101.

Claim 22 should be patentable, as claim 22 includes each of the limitations of claim 1 as originally filed and allowed claim 9 as originally file. Claim 23 should be patentable, as claim 23 includes each of the limitations of claims 1 as originally filed and allowed claim 10 as originally filed. Claim 27 should be patentable, as claim 27 includes each of the limitations of claims 1, 3, and 5 as originally filed and allowed claim 6 as originally filed.

Appl. No. 09/978,306
Amdt. dated April 22, 2004
Reply to Office Action of February 23, 2004

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



Rodney C. LeRoy
Reg. No. 53,205

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300
RCL:cmm
60165758 v1